

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEOFFREY MICHAEL BERTOLINI

Appeal No. 2004-2059
Application No. 10/278,725

ON BRIEF

Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2, 5-18 and 22, all the claims currently pending in the application.

Appellant's invention pertains to a decking tile. As explained in the summary of the invention on page 2 of appellant's brief, the decking tile of the present invention comprises a base support structure that serves as a support base for slats, cladding, tiles or other flooring material, which are

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placed thereon and are attached with fasteners. Appellant's decking tile comprises a plurality of portions arranged in an array and connected to adjacent portions by membranes that may be severed so that one or more of the portions may be removed. This allows flexibility in the design of a completed deck comprising a plurality of interconnected decking tiles because the individual decking tiles can be customized to accommodate different room shapes and sizes and circumscribe pipes and the like. A further understanding of the invention can be derived from a reading of exemplary claim 1, which reads as follows:

1. A decking tile divided into a plurality of portions arranged in an array, said portions being connected to each adjacent portion by a membrane adapted to be severable, each portion being removable from said tile upon severing of the membranes connecting it to the other portions, each portion arranged to receive at least two fasteners to secure a slat thereto, wherein said at least two fasteners can engage a slat positioned to any side of said tile.

The references applied by the examiner in the final rejection are:

Boyd	5,263,289	Nov. 23, 1993
Hayashi	JP 1-275802 A	Nov. 6, 1989
(published Japanese Kokai Patent Application)		

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Claims 1, 2, 5-11, 14, 16-18 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Boyd.

Claims 12, 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd in view of Japanese patent document 1-275,802 to Hayashi.

Reference is made to appellant's brief (Paper No. 7) and to the examiner's answer (Paper No. 8) for the respective positions of appellant and the examiner regarding the merits of these rejections.

Discussion

Looking first at the examiner's anticipation rejection of claim 1, Boyd pertains to modular hollow floor panels, which in use are laid in a continuous two-dimensional array over a supporting sub-surface to form a hollow floor, wall or ceiling suitable for reticulating electrical, optic-fiber, hydraulic and other conduit. Figures 1-3 illustrate a first modular floor panel embodiment. In the words of Boyd:

This panel has a flat upper surface, and the underside is criss-crossed with a series of "vaults" (1) which define channels through which the cabling may be laid. The channels occur in at least two directions: a first set of channels runs laterally from one side of the panel to the other, and a second set of channels runs longitudinally from one end of the panel to the other. Diagonal and vertical channels are also possible, and formations with these features will be

described later. Between the said vaults, there are slits (2) which divide the panel into an array of rigid sub-elements in the form of pedestals, which are inter-connected by small cross-sections of material (3). This allows the panel to flex and to accommodate undulations in the surface of the structural sub-floor. [Column 3, lines 11-25.]

Figures 6-9 illustrate a second modular floor panel embodiment. According to Boyd:

This second type of construction differs from the first in that additional slits (5) are provided which divide the panel into triangular sub-elements (6). Triangular sub-elements have the advantage of accommodating to an uneven sub-surface, and this type of construction is applicable to the use of rigid materials such as pressed steel, cast aluminium, or rigid plastics. [Column 3, lines 59-65.]

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984). It is not necessary that the reference teach what the subject application discloses and claims, but only that the claim on appeal "reads on" something disclosed in the reference, i.e., that all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983),

cert. denied, 465 U.S. 1026 (1984). Concerning inherency, it is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether there was a recognition that it could be used to perform the claimed function. *See, e.g., In re Schrieber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

As framed by appellant, the issue with respect to the standing anticipation rejection of claim 1 is whether the floor panel of Boyd's Figures 6-9 embodiment includes portions that are connected to each adjacent portion by "a membrane adapted to be severable" so that "each portion [is] removable from said tile upon severing of the membranes connecting it to the other portions." Appellant argues (brief, page 5) that it does not necessarily follow that the panel system of Boyd, even when made of rigid plastic and composed of cross-sections (3) of thinner material to provide panel flexibility, would be adapted to be severable. Appellant further argues (brief, page 6) that the examiner speculatively concludes that elements (3) of Boyd are inherently adapted to be severable, and that this speculative conclusion is inconsistent with the law of inherency.

Independent claim 1 sets forth a decking tile divided into a plurality of portions, with the portions being connected to each adjacent portion by a "membrane." First, although Boyd does not use the word "membrane" to describe the small cross-sections of material (3), the examiner's determination that these thin elements (3) constitute membranes is reasonable on its face when the term "membrane" is read in light of appellant's specification and the commonly accepted meaning of that term.¹ Second, independent claim 1 also contains several non-structural, functional limitations of the claimed "membrane" describing the membrane's capabilities and how these capabilities impact on the manner in which the decking tile may be used. More particularly, claim 1 describes the membrane as being "adapted to be severable" so that "each portion [is] removable from said tile upon severing of the membranes connecting it to the other portions." Based on the fact that the Figures 6-9 panel of Boyd may be constructed of rigid plastic (column 3, lines 64-65), and that the connecting elements (3) are described in the Boyd specification as being of

¹We observe that the word "membrane" may mean "[a] thin pliable layer of tissue covering surfaces or separating or connecting regions, structures, or organs of an animal or plant." *Webster's II New Riverside University Dictionary*, copyright © 1984 by Houghton Mifflin Company.

small cross-section to allow the panel to flex (column 3, lines 20-23), and the showing in Boyd's drawing figures of elements (3) as being of considerably smaller thickness than adjacent portions of the floor panel, the examiner's finding that the above noted non-structural, functional limitations of claim 1 are inherent in Boyd is well founded and not based on speculation. Stated differently, the description provided in Boyd for the connecting elements (3) constitutes evidence that supports the examiner's reasonable determination that Boyd's elements (3) are capable of being severed to allow removal of a selected portion of decking tile, such that the "membrane adapted to be severable" limitation of claim 1 "reads on" Boyd's elements (3).

As to appellant's argument in the brief to the effect that the examiner's treatment of the functional "adapted to be severable" limitation of claim 1 is inconsistent with the law of inherency, we point to the statement by the Court in *Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432, that

[a] patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 58 C.C.P.A. 1027, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than by what it is] in drafting patent claims."). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a

risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

See also *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); *In re Ludtke*, 58 C.C.P.A. 1159, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

In this case, as in *Schreiber*, we have considered the functional limitations asserted by appellant as distinguishing of Boyd and agree with the examiner that these limitations relate to functional characteristics and intended use of the claimed device, that they do not lend patentable weight to the presently claimed subject matter, and that the limitations in question are in fact inherent characteristics of the floor panel of Boyd. Thus, we consider that the examiner has established a *prima facie* case of anticipation that appellant has not overcome by convincing argument or evidence to the contrary.

In light of the above, we shall sustain the rejection of claim 1 as being anticipated by Boyd. We shall also sustain the anticipation rejection of claims 2, 5-11, 14, 16-18 and 22 as

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being anticipated by Boyd because these claims have not been separately argued with any reasonable degree of specificity apart from claim 1. *See, for example, In re Hellsund*, 474 F.2d 1307, 1309-10, 177 USPQ 170, 172 (CCPA 1973); *In re Wood*, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); and *In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

Turning to the rejection of claims 12, 13 and 15 as being unpatentable over Boyd in view of Hayashi, we also shall sustain the rejection of these claims since appellant has not separately argued the merits of these claims with any reasonable degree of specificity.

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The decision of the examiner finally rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

LJS:hh

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HOGAN & HARTSON, LLP
ONE TABOR CENTER, STE. 1500
1200 SEVENTEENTH ST.
DENVER, CO 80202